

REMARKS

Claims 1-20 are now pending in the application. Claim 11 has been amended. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Examiner provides various assertions as to why the range of 0.1 to 0.49% photoinitiator does not comply with the written description requirement and has requested different correlations of the claims to the examples. First, the Examiner asserts that Sample 1 (in Table 1) is not clearly an example of the claimed compositions as various elements of the claimed composition are missing from Table 1. Applicants respectfully point out that Table 1 and the percentages of photoinitiators in Samples 1, 2, and 3 are not viewed in isolation, but highlight a single component of the general formulations taught by the present teachings (Paragraphs [0009] and [0011]). This is further supported by the heading of Table 1 – “Evaluation of Primers for Surface Cure” – referring to primers according to the present teachings. The only composition in Table 1 that is not according to the present teachings is indicated by the “Control*” heading as the Control composition is the metric used to compare the composition embodiments having the various amounts of photoinitiator. Accordingly, Sample 1 and Table 1 are examples of compositions corresponding to various embodiments of the present teachings.

Second, the Examiner requests that Applicants relate the compositions and percentages of photoinitiators in Sample 1 and Table 1 to particular claims. As stated by the Court of Customs and Patent Appeals, “[w]hat the Patent Office is here apparently attempting is to limit all claims to the specific examples, notwithstanding the clear disclosure of a broader invention. This it may not do.” In re Anderson, 176 U.S.P.Q. 331 (C.C.P.A. 1973). Applicants need not correlate the claims to specific examples as the examples are simply illustrations of different embodiments of the invention, the examples are not reflective of every possible embodiment of Applicants’ invention, and correlation of the examples to specific claims may unnecessarily limit the claims covering a broader invention to only the specific examples detailed in the specification.

As a further demonstration of written support for the range of 0.1% to 0.49% photoinitiator, Applicants clearly state that “[a]ll ranges of amounts are intended to include each and every point within the range.” (Paragraph [0011]). The 0.5% photoinitiator in Sample 1, the general formulations including ranges of 0.1 to 0.98% or 0.1 to 0.95% photoinitiator, and the specific teaching that “each and every point within the range” is included in the ranges, demonstrate that there is more than adequate disclosure of a range of 0.1 to 0.49% photoinitiator, as 0.1, 0.49, and all points in between are included in “each and every point within the range” of 0.1 to 0.98%.

As Applicants have provided proper written description for each of the claims, the §112 rejection is improper. Removal of the rejection and reconsideration of the claims are respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fenn et al. (U.S. Pat. No. 6,838,177). This rejection is respectfully traversed.

At the outset Applicants point out that claim 11 has been amended to recite that the method consists essentially of applying the UV radiation curable primer to a substrate and curing the primer with the selected sources to obtain a tack free surface after 2 – 5 minutes. To provide a tack free surface using the higher amounts of photoinitiator taught by Fenn et al., the user must perform an additional processing step of wiping the surface with a solvent. (Column 5, lines 35-45). According to Applicants teachings, the tack free surface is provided after curing and does not require any additional solvent preparation or wiping the surface with the solvent, partly due to the low amount of photoinitiator and the curing conditions. Accordingly, the §103 rejection for claim 11 and its dependent claims is improper. Removal of the rejection and reconsideration of the claims are respectfully requested.

With respect to claim 1 and its dependent claims as well as claim 11 and its dependent claims, Fenn et al. does not function according to the present teachings without a photoinitiator concentration of greater than 1%. Fenn et al. teaches that dropping the photoinitiator level below 1% may cause the composition to be tacky following exposure to UV radiation for 1 to 3 minutes. (Column 5, lines 35-45). It is not possible to use the disclosed photoinitiator range of Fenn et al. and then provide a non-tacky surface after only 2 to 5 minutes of radiation under the curing conditions as claimed by Applicants. Accordingly, the §103 rejection is not supported by the Fenn et

al. disclosure and claims 1 and 11 and all dependent claims are patentably distinct from Fenn et al. Removal of the rejection and reconsideration of the claims are respectfully requested.

Additionally, with respect to Examiner's comments regarding the use of natural light, Applicants respectfully point out that the combination of a low photoinitiator concentration within Applicants' claimed range and natural light is highlighted in Example 3. The Specification at page 9, line 14 reads "Example 3." The Specification at page 10, line 15 is blank. The Specification at page 9, line 16 reads "Primer Cured in Outdoor Natural Light." The Specification at page 9, line 17 reads "The following ingredients were mixed together to form the primer composition." The Specification then shows the table having a photoinitiator in an amount of 0.16 grams. The total primer composition weight is 94.67 grams. The photoinitiator comprises 0.17% of the primer ($0.16/94.67 = .00169$ or 0.17%). Example 3 is the primer composition used in Table 3, and Table 3 demonstrates the adhesion and humidity resistance benefits obtained by using natural light and the low photoinitiator concentration. Accordingly, the §103 rejection is not supported by the Fenn et al. disclosure and claims 1 and 11 and all dependent claims are patentably distinct from Fenn et al. Removal of the rejection and reconsideration of the claims are respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is

believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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